

### **REMARKS**

Claims 1-6, 8-11, 20-39 and 41-55 are pending, with claims 1, 11, 30, 50-52 and 55 being independent. Claim 55 has been amended to correct an informality, clarifying the claim limitation as suggested by the Examiner in the Office Action. Additionally, entry of this amendment does not require further search and/or consideration. No new matter has been added. Thus, entry of the Amendment is respectfully requested.

### **Claim Objections**

The Examiner objected to claim 55 for an informality with respect to the limitation “the particular insurance plan being is not.” Applicant has clarified this limitation to recite “the particular insurance plan being proposed is not” in this Amendment. Thus, withdrawal of this objection is respectfully requested.

### **Claim Rejections- 35 U.S.C. § 101 and § 112**

The Examiner withdrew the rejection of claims 1-10, 20-29, 50 and 53-54 under 35 U.S.C. § 101 and the rejection of claims 1-10, 20-29, 50 and 50-54 under 35 U.S.C. § 112. Applicant thanks the Examiner for withdrawing these rejections.

### **Claim Rejections – 35 U.S.C. § 103(a)**

The Examiner rejected claims 1-6, 8-11, 20-39 and 41-55 under 35 U.S.C. § 103(a) as being unpatentable over Lockwood (U.S. Patent No. 4,567,359, hereinafter as “Lockwood”) in view of Warady (U.S. Patent No. 6,067,522, hereinafter as “Warady”) and Tyler (U.S. Patent No. 5,523,942, hereinafter as “Tyler”) for substantially the same reasons given in the prior Office Action of May 13, 2009.

Applicant respectfully traverses these rejections.

**Claims 1, 11, 30 and 50-52** recite, in part, “an indication that the particular insurance plan

being proposed is **not currently configured** for the customer, and an indication of what conditions are not met for the customer to qualify for the proposed **but currently not configured** insurance plan.”

The Examiner, at pages 3, 13 and 14 of the final Office Action, asserted that the word “prerequisites” [sic.] disclosed in Warady teaches the above limitation. Applicant submits that an act of displaying all prerequisite conditions for a benefit does not teach or suggest an act of presenting an indication of what conditions are not met for the customer to qualify for the proposed but currently not configured insurance plan. In other words, Warady may teach displaying all prerequisite conditions for a specific benefit before the employees enroll in the benefit such that they can see if they are eligible for the specific benefit. This teaching of Warady has nothing to do with an act of presenting an indication that the particular insurance plan being proposed is not configured for the customer, and an indication of what conditions are not met for the customer to qualify for the proposed but currently not configured insurance plan.

Thus, Applicant submits that Warady’s prerequisite conditions do not read on an indication that the particular insurance plan being proposed is not currently configured for the customer or an indication of what conditions are not met for the customer to qualify for the proposed but currently not configured insurance plan.

Further, claim 1 requires, in part, “**determining** if a particular insurance plan **may be proposed but is not currently configured for** the customer” as recited in the second paragraph of claim 1. Claims 11, 30 and 50-52 also recite a similar limitation to the above limitation recited in claim 1.

Regarding this limitation, the Examiner, at page 14 of the Office Action, stated,

As per Applicant's assertion in paragraph 1 on page 19 of the 13 August 2009

response that the Warady reference teaches away from "determining if a particular insurance plan may be offered despite the fact that one or more requirements are not currently met," Examiner respectfully notes that this is not a claimed limitation.

As discussed on pages 18-19 of the Amendment filed on August 13, 2009, Applicant submits that Warady's method merely determines **if a prerequisite is met to deny or approve** an employment's application for a benefit. So, if a requirement is not met, the enrollment application is denied, i.e., not be offered to the employee. In fact, Warady teaches away from determining **if a particular insurance plan may be proposed** despite the fact that one or more requirements are not currently met. In other words, Warady teaches away from determining if a particular insurance plan may be proposed when there is a prerequisite condition that an employee does not meet, i.e., Warady teaches away from "determining if a particular insurance plan may be proposed but is not currently configured for the customer based upon the stored plan requirements data."

In line with the above assertion stated on page 14 of the Office Action, the Examiner alleged that Applicant's assertion that "Warady teaches away from determining if a particular insurance plan may be proposed despite the fact that one or more requirements are not currently met" is not a claimed limitation. Applicant submits that the claimed limitation itself denotes that the particular insurance plan may be proposed despite the fact that one or more requirements are not currently met because the claim recites, in part, "determining if a particular insurance plan may be proposed but is not currently configured for the customer based upon the stored plan requirements data" and "an indication of what conditions are not met for the customer to qualify for the proposed but currently not configured insurance plan."

Thus, Warady does not teach or suggest the limitation, "determining if a particular insurance plan may be proposed but is not currently configured for the customer based upon the stored plan requirements."

Regarding other limitations recited in these claims, Applicant incorporates herein by reference the arguments and remarks presented in the Amendment filed on August 13, 2009 and the Supplemental Amendment filed on October 21, 2009.

For the reasons stated above, withdrawal and allowance of claims 1, 11, 30 and 50-52 and all of the dependent claims are respectfully requested. Additionally, Applicant traverses the rejection of claims 50-52 as discussed below.

**Claims 50-52** recite, in part, “generating a customized proposal in the computer system that is different from the stored insurance products by the comparing the customer data.”

The Examiner, at page 12 of the final Office Action, asserted that Lockwood teaches this limitation and cited column 2, lines 47-59 of Lockwood.

Lockwood, at column 2, lines 35-59, states:

The central data processing center **stores information on the services and prices offered by each institution** and on customer sales completed by each sales and information terminal. The central data processing center is programmed to transmit periodically to each institutions' data processing terminal, either directly or indirectly, for example through an automated telecommunication network service such as TELENET ®; up-dated [sic.] information on sales made by the system for that institution. The center is also programmed to receive information on any changes in prices or services offered by each institution in the same way, and up-date [sic.] the information stored accordingly.

Each sales and information terminal is programmed to gather a predetermined sequence of information from a customer on the services in which the customer is interested, and to transmit the information to the central data processing center. In response to the gathered information, the central data processing center **extracts the desired information from its storage** and transmits it back to the terminal where it is relayed to the customer.

Subsequently, the terminal is programmed to accept an order for **the offered services** from the customer, to collect payment and to dispense the services to the customer. (emphasis added)

Here, the offered services in line 57 refer to the stored services offered by each institution in line 36 and the desired information extracted from the storage in line 54. As such, the **offered**

services (personalized insurance quotations) is the same as the stored information on the services offered by the institution in Lockwood, while these claims require that the generated customized proposal be different from the stored insurance products. Thus, Applicant submits that Lockwood's teaching of extracting personalized insurance quotations from its stored information does not teach or suggest the limitation "generating a customized proposal in the computer system that is different from the stored insurance products by the comparing the customer data."

Additionally, the Examiner, at page 12, last paragraph, of the Office Action, asserted that Warady, at column 8, lines 26-30, teaches this limitation.

Warady, at column 8, lines 26-30, states: "The data entry and user interface module 50 enables a user of the health and welfare benefit enrollment and billing system 1 to enter, review, extract, and modify the data stored in the various files of the health and welfare benefit enrollment and billing system 1."

The Examiner asserted that extracting and modifying the data stored in the various files of the health and welfare benefit enrollment and billing system teach this limitation. Applicant submits that Warady might teach modifying the health and welfare benefit data stored in the system and extracting the modified data. As such, Warady's extracted data is the same as its stored data. As discussed above regarding Lockwood, simply extracting the modified benefit plan in the system does not teach or suggest the limitation, "generating a customized proposal in the computer system that is different from the stored insurance products by the comparing the customer data."

Therefore, Applicant submits that claims 50-52 should be allowable.

Regarding claims 2-6, 8, 10, 20-23 and 28-29, the Examiner, at page 4 of the Office Action, stated, "the recited claimed features are rejected for the same reasons given in the prior

Office Action” of May 13, 2009 (hereinafter as “the prior Office Action”). Applicant submits that these claims should be allowable because their base claims are patentable as discussed above. Additionally, Applicant traverses the rejection of claims 3 and 21-23 as discussed below.

Regarding **claim 3**, the Examiner, at page 12, paragraph (B), of the prior Office Action, stated: “wherein the generating step comprises providing insurance company data as part of the customized proposal (Lockwood; Abstract, column 1, lines 20-36, column 1, line 45 to column 2, line 60, column 3, lines 9-48, column 5, line 65 to column 6, line 32, column 7, lines 5-24, column 7, line 60 to column 8, line 2, column 9, lines 13-30).”

Regarding the limitation “insurance company data,” the present specification, at paragraph [0070], defines it as “documentation regarding the insurance company.” Applicant submits that Lockwood, especially in the passages cited by the Examiner, might teach providing an insurance quotation from each participating company (see column 7, lines 5-13 of Lockwood, for example), but it does not teach or suggest providing documentation regarding the insurance company in the generated customized proposal.

Thus, Applicant submits that claim 3 should be patentable on its own merit.

Regarding **claim 21**, at page 16, first paragraph, of the prior Office Action, the Examiner stated: “wherein the generating step comprises gathering ‘predetermined customer information’ (reads on providing insurance application forms” [sic.]) as part of the customized proposal (Lockwood; column 3, lines 15-16).”

Lockwood, at column 3, lines 12-16, states: “The terminals are all linked to the central data processing center and each include [sic.] a data processor programmed to transmit preselected information to a customer and to gather *predetermined customer information*.” (emphasis added)

The Examiner asserted that the “predetermined customer information” reads on the

limitation “providing insurance application forms as part of the customized proposal.”

Applicant submits that an act of gathering predetermined customer information, such as names, address, ages and so forth, does not teach providing insurance application forms. Moreover, the act of gathering predetermined customer information is a process necessary to provide a quote, that is, it is not a part of the customized proposal. Thus, the predetermined customer information does not read on the limitation “providing insurance application forms as part of the customized proposal.”

Therefore, it is submitted that claim 21 should be allowable on its own merit.

**Claim 22**, recites, in part, “wherein the generating comprises providing benefit charts data as part of the customized proposal.”

Regarding claim 22, the Examiner, at page 16, second paragraph, of the prior Office Action, stated: “wherein the generating step comprises providing ‘a series of quotations from various institutions ... purchaser can compare quotations’ (reads on ‘benefit charts data’) as part of the customized proposal. (Lockwood; column 3, lines 32-33).”

However, Lockwood, at column 3, lines 32-33, states: “A prospective insurance purchaser may receive a series of quotations from various institutions quickly.”

The Examiner asserted that the “quotations” read on the limitation “benefit charts data.” However, the present specification, at paragraph [0070], defines the benefit charts data as “a set of charts summarizing all of the insurance plans in a common format to permit an easy comparison of benefits provided by each plan.”

Webster’s Third New International Dictionary, page 1868, 1993 (copy attached), defines the term “quotation” as “the act or process of quoting <his ~ of prices>; *esp* : the naming or publishing of current bids and offers or current prices of securities or commodities; *also* : the bids,

offers, or prices so named or published.” Applicant submits that quoting a price of an insurance plan does not teach or suggest providing benefit charts data as part of a customized proposal.

Thus, it is submitted that claim 22 should be allowable on its own merit.

**Claim 23** recites, in part, “wherein the generating comprises providing provider information data as part of the customized proposal.”

The Examiner, at page 16, third paragraph, of the prior Office Action, stated, “wherein the generating step comprises providing provider information data as part of the customized proposal (Lockwood; column 7, lines 5-12).”

However, Lockwood, at column 7, lines 5-12, states:

Once all the necessary information has been gathered at the terminal (see 44), the processing unit 14 auto-dials the central data processing center 1 (see 45, FIG. 5), sends the gathered information to the center (46) and waits to receive an insurance quotation from each participating company. The central data processing center performs the desired quote, as will be described in connection with FIG. 6 below, and sends the quote back to the terminal.

Regarding the term “provider information,” the present specification, at paragraph [0070], states: “The Provider Info Material Module 1016 includes documentation of the health care provide[r]s who are included within each plan.” Lockwood, at the above passage cited by Examiner, simply describes that the central processing unit sends the quote to the terminal. Applicant submits that merely providing a quote does not teach or suggest providing provider information data as part of the customized proposal.

Thus, it is submitted that claim 23 should be allowable on its own merit.

Regarding **claims 9, 24-27, 31-39, 41-49, 53 and 54**, the Examiner, at page 4 of the Office Action, rejected these claims “for the same reasons given in the previous Office Action (paper number 20090428, section 10, pages 6-24), and incorporated herein.” Applicant submits that these



claims should be patentable because their base claims are patentable, as discussed above. Additionally, Applicant traverses the rejection of claims 27 and 53 as discussed below.

**Claim 27** recites, in part, “wherein the insurance plan comprises a set of insurance plans.” Regarding claim 27, the Examiner, at page 16, paragraph (G), of the prior Office Action, stated, “wherein the insurance plan comprises a set of insurance plans (Warady; column 4, lines 1-19).”

However, Warady, at column 4, lines 1-19, simply provides a list of benefit plans. Applicant submits that the benefit plans listed by Warady do not teach or suggest generating a customized proposal for a set of insurance plans at the same time.

Thus, it is submitted that claim 27 should be patentable for its own merit.

**Claim 53** recites: “The method of claim 1, further comprising: tracking the status of proposals; storing and printing sales collateral material and forms; and providing a product discovery consultation function.”

Regarding the limitation of “storing and printing sales collateral material and forms,” the Examiner, at page 24, paragraph (N) of the prior Office Action, stated, “storing and printing sales collateral material and forms (Lockwood; Abstract, column 1, lines 45-55, column 6, lines 10-11).” Lockwood, especially in the above-cited passages by the Examiner, teaches printing out the quote. Regarding the collateral material, the present specification, at paragraph [0070], states: “The Collateral Sales Material Module 1015 includes other sales material useful in the sale of insurance products to customers.”

As such, Lockwood’s teaching of printing out a quote has nothing to do with storing and printing sales collateral materials which are sales materials useful in the sale of insurance products to customers other than the quote.

Thus, it is submitted that claim 53 should be patentable for its own merit.

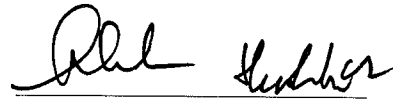
Regarding **claim 55**, the Examiner, on pages 5-7 of the Office Action, rejected this claim for similar reasons as those of claim 1. As such, Applicant submits that claim 55 should be patentable for, at a minimum, the same reasons as for claim 1.

Applicant has addressed the issues raised by the Examiner in the Response to Arguments section on pages 8-15 of the Office Action. Accordingly, reconsideration of the outstanding Office Action and allowance of the present application and all the claims herein are respectfully requested and now believed to be appropriate.

It is believed that all of the pending issues have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this reply should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this reply, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Should the Examiner have any questions or comments regarding this matter, the undersigned may be contacted at the below-listed telephone number.

Respectfully submitted,  
Jerome D. JOHNSON et al.

A handwritten signature in black ink, appearing to read 'Abraham HersHKovitz', written over a horizontal line.

Abraham HersHKovitz  
Reg. No. 45,294

Dinh X. Nguyen  
Reg. No. 54,923

Jae Youn Kim  
L0485

Date: April 19, 2010  
HERSHKOVITZ & ASSOCIATES, LLC  
2845 DUKE STREET  
ALEXANDRIA, VA 22314  
(703) 370-4800  
(703) 370-4809 (FAX)  
patent@hershkovitz.net

AH/DXN/SK/pjj/cgvr